

REMARKS/ARGUMENTS

Claims 11, 18 and 19 are currently amended in order to improve their clarity. In particular, claim 19 is amended to particularly point out the Applicants' inventive "card".¹

A. CLAIM REJECTIONS UNDER 35 U.S.C. § 101

The Examiner has rejected claims 11, 13, 14, and 16-18 under 35 U.S.C. § 101 as being not directed to statutory subject matter, because they are contended not to be within the technological arts. In response, the Applicants have amended independent claims 11 and 18 to recite the claimed steps are part of a method implemented on a computer. Consequently, these claims as amended, as well as their dependent claims 13, 14, 16, and 17, are within the technological arts.

In conclusion, these claims are submitted to be directed to statutory subject matter because they are within the technological arts and, as the Examiner has found, they produce a "useful, concrete, and tangible" results. Accordingly, it is respectfully requested that the instant rejections be withdrawn.

B. CLAIM REJECTIONS UNDER 35 U.S.C. § 103

The Examiner has rejected claims 1-3, 5, 6, 8, 11-13, 15, 16, 18, and 19 under 35 U.S.C. § 103 as being unpatentable over US patent no. 5,031,161 to Kendrick ("Kendrick") in view of US patent no. 5,692,501 to Minturn ("Minturn").

THE REJECTION OF CLAIM 1

In order that one or more references establish *prima facie* obviousness of a claimed invention, it is well known to be necessary that the references teach all limitations of the claims.² Therefore, with respect to claim 1, it is necessary that the references teach, *inter alia*, the element:

¹ See, for example, the specification at page 5, lines 21 to page 6, line 3; and page 12, lines 4-11

² See, for example, M.P.E.P. § 2142.

a means for predicting life expectancy based upon said health profile data and said altered or adjusted data.

However, before determining whether Kendrick and Minturn disclose such a teaching, it is first necessary to correctly determine the scope of this element.³

Because this element is clearly in means plus function form it must be interpreted according to 35 U.S.C. 112 ¶6. This element is in means plus function form because, for example, it meets the criteria set forth in M.P.E.P. §2181. In particular, this element includes the phrase "means for", and further it recites the function "predicting life expectancy" without structure or acts performing this function. Thus, the correct interpretation of this element can only be ascertained by locating the specific structures and acts disclosed in the specification for "predicting life expectancy". The M.P.E.P states:

Where means plus function language is used to define the characteristics of a machine or manufacture invention, claim limitations must be interpreted to read on only the structures or materials disclosed in the specification and "equivalents thereof." . . . Two *en banc* decisions of the Federal Circuit have made clear that the Office is to interpret means plus function language according to 35 U.S.C. 112, sixth paragraph.⁴

Review of the specification readily reveals that structures and acts for "predicting life expectancy" can be found, for example, in the specification at page 8, line 12 to page 9, line 14. These lines establish that the "means" of this element is a microprocessor with particular disclosed characteristics and loaded with particular disclosed health profile data and that determines according to a program a life expectancy value.

As correctly interpreted above, this element is not taught by either Kendrick or Minturn (nor their combination). The Examiner relies only on col. 4, lines 1-22, col. 5, line 54 to col., line 65 in Kendrick for such a teaching.⁵ But, Kendrick in cols. 4 and 5 does not teach a

³ See, for example, M.P.E.P. § 2106 (p. 2100-6 of ed. 8, rev. 1 (Feb. 2003)).

⁴ See, for example, M.P.E.P. § 2106 (p. 2100-9 of ed. 8, rev. 1 (Feb. 2003)) (emphasis added).

"microprocessor" that carries out "predicting life expectancy based upon said health profile data". Instead, Kendrick teaches only that the user must enter a current life expectancy into

registers 56a-56e using buttons 32 and 34. Kendrick's watch then merely decrements the entered values. Kendrick merely suggests that the user can determine a value to enter by consulting certain actuarial-type tables. Kendrick states:

The value(s) entered into the system by the user can be determined by the actuarial Table I data, shown below.⁶

Further, careful reading shows that the process executed by Kendrick's watch does no more than either display the time remaining or accept input for updating the registers 56a-56e.⁷

Thus, this watch does not perform any automatic determination of life expectancy values whatsoever; the actuarial tables are for the user's consideration. Kendrick does not teach loading these tables into the watch. Such manual activity by the user is not "microprocessor" implemented "lifespan prediction" as this element recites.⁸ Kendrick discloses the his watch may also have questions that suggest health factors for the user.⁹ But here also, it is only the user that manually determines a value to enter into the watch.

Minturn also does not disclose any "microprocessor" that carries out "predicting life expectancy based upon said health profile data", and the Examiner does not so contend. Minturn merely compares individual health data to a "scientific wellness database" and outputs a large number of personal evaluations and recommendations.¹⁰ Neither, does Minturn suggest automatic determination of life expectancy values.

⁵ The Examiner also relies on claims 1 and 5. But since the claims are interpreted in view of Kendrick's specification, they add nothing to Kendrick's disclosure, and in fact merely confirm this discussion.

⁶ Kendrick, col. 4, lines 3-5.

⁷ Kendrick, col. 6, line 38 to col. 7, line 9; and Fig. 4.

⁸ In fact, this activity is non-statutory subject matter.

⁹ Kendrick, col. 6, lines 30-37

¹⁰ See, for example, Minturn at col. 12, lines 48-54 and Figs. 3-9.

Moreover, the Applicants remark that the nature of the "health profile data" as described in the specification and recited in the claims is different from the data of either Kendrick or

Minturn. The "health profile data" of this invention reflects the medical history and life experience of individual patients. In contrast, the data disclosed by Kendrick includes only registers 56a-56e (the standardized actuarial tables being only for the user's consideration); the

data disclosed by Minturn concerns only individuals in optimal health and fitness.¹¹ Neither of these types of data reflects individualized patient histories.

Lastly, neither of the additional references, US patent no. 5,937,387 by Summerell et al. ("Summerell") or US patent no. 5,867,821 by Ballantyne et al. ("Ballantyne"), either together or in any combination with Kendrick and Minturn teach a "microprocessor" that carries out "predicting life expectancy based upon said health profile data". The Examiner does not so contend.

In conclusion, because the Kendrick and Minturn (nor the Summerell and Ballantyne) references do not disclose or teach all the elements of this invention, these references cannot establish the *prima facie* obviousness of claim 1.

THE REJECTIONS OF THE REMAINING CLAIMS

The remaining independent claims, claims 11, 18, and 19 as amended, are substantially similar to the correctly interpreted claim 1. They now explicitly recite "predicting life expectancy based upon [*inter alia*] said health profile data", where such predicting is performed automatically by a computer (claim 19) or by a computer-implemented method (claims 11 and 18). Therefore, like claim 1, these claims are also not obvious over Kendrick and Minturn for the above reasons.

Since dependent claims incorporate all elements of their parent claims, the remaining dependent claims are also not obvious over Kendrick and Minturn.


¹¹ See, for example, Kendrick at Tables I and II; and Minturn at col. 12, lines 48-53

CONCLUSION

The Applicants respectfully request entry of the foregoing amendments and remarks into the file of the above-captioned application. The Applicants believe that each ground for rejection or objection has been successfully overcome or obviated and that all the pending claims are in condition for allowance. They earnestly request reconsideration and withdrawal of the Examiner's objection and rejections and allowance of the application.

If any issues remain, the Applicants invite the Examiner to telephone the undersigned to discuss the same and to arrange for prompt and efficient handling of the above-captioned application.

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